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BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO IL 60610

In re Application of :
Baker et al. :
Serial No.: 09/990,711 : PETITION DECISION
Filed: November 14, 2001 :
Attorney Docket No.: P2730P1C2 :

This letter is in response to the Petition under 37 CFR 1.181, filed March 9, 2006 requesting (1) that the rejections containing the six new references which have been used by the examiner in the Examiner's Answer be designated as new grounds of rejection; (2) that the examiner provide a corrected Examiner's Answer which identifies the rejections as new grounds of rejection; and (3) that prosecution be reopened because of these new grounds of rejection.

BACKROUND

On February 8, 2005, the examiner issued a Final Office action. Applicants filed a Notice of Appeal on August 3, 2005 and an Appeal Brief on November 3, 2005. The examiner mailed to applicants an Examiner's Answer on January 11, 2006. Applicants filed a Reply Brief on March 9, 2006 along with a request for an Oral Hearing and this petition.

DISCUSSION

In the Examiner's Answer, the examiner relied extensively on six new references in order to support the lack of utility and/or lack of enablement rejections. These new references are:

LaBaer ; 2003, Nature Biotechnology 21 :976-977.
Chen et al.; 2002, Molecular and Cellular Proteomics 1:304-313.
Gygi et al.; 1999, Mol. Cell. Biol. 19 :1720-1730.
Lian et al.; 2001, Blood 98:513-524 ; and
Fessler et al.; 2002, J. Biol. Chem. 277:31291-31302.
Greenbaum et al, 2003, Genome Biology 4 :117.1-117.8.

The statutory basis of the rejections 35 USC 101 and 112, first paragraph) in the Examiner's Answer did not change from the FINAL office action mailed to applicants on February 8, 2005. However, it is clear that the examiner used the additional six new references to reinforce these rejections and rebut more thoroughly applicants' arguments. While the applicants did respond to

these new arguments and new references raised by the examiner in the Examiner's Answer in their Reply Brief, they argue that they have been placed at a disadvantage because they are limited in their ability to present substantive evidence of their own in response to these new references and arguments without the reopening of prosecution being granted.

DECISION

For the above reason, the petition under 37 CFR 1.181 requesting (1) that the rejections containing the six new references which have been used by the examiner in the Examiner's Answer be designated as new grounds of rejection; (2) that the examiner provide a corrected Examiner's Answer which identifies the rejections as new grounds of rejection; and (3) that the FINALITY be withdrawn and that prosecution be reopened because of these new grounds of rejection is **GRANTED-IN-PART**.

Applicants' first request that the rejections in the Examiner's Answer be designated "new grounds of rejection" is **GRANTED**.

Applicants' second request has been effectively granted by this Decision on Petition designating the rejections in the Examiner's Answer to be "new grounds of rejection." The further request for the corrected Examiner's Answer is deemed to be moot in view of the Decision on Petition and therefore, **DISMISSED**.

Applicants' third request to have the FINALITY of the application withdrawn and prosecution reopened is **GRANTED** as this is a proper request under the Rules of Prosecution when a new ground of rejection is advanced in an Examiner's Answer. (Alternatively, applicants may rely solely on their Reply Brief and proceed to the Board.)

In view of applicants' expressed limited ability to present new evidence, as noted above, applicants are given TWO MONTHS from the mailing date of this Decision within which to submit any additional arguments, exhibits, affidavits or other evidence which they consider necessary in order to rebut the examiner's new grounds of rejection set forth in the Examiner's Answer. Failure to make any submission will be taken as applicants' agreement to rely solely on the already submitted Reply Brief.

This application is being returned to the examiner for consideration of the Reply Brief which will be treated as a reply to a new "Non-Final" rejection set forth in the Examiner's Answer and further action not inconsistent with this decision.

Applicants have been charged a fee of $130.00 for this petition. However, since there should be no charge for this petition, this $130.00 will be credited to applicants' Deposit Account No. 08-1641.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.

George C. Elliott

George Elliott
Director, Technology Center 1600